

## REMARKS

As a result of this amendment, claims 13 and 20 are amended.

### Claim Rejections – 35 USC §103

According to the MPEP, section 2143, the Examiner must establish three basic criteria to form a *prima facie* rejection based on obviousness. First, there must be some suggestion or motivation, either in the knowledge generally available or to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be some reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claimed limitations.

*In re Fine*, 837 F.2d 1071, 350, 5 USPQ 2d 1596 (C.A.F.C. 1992) states:

"The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785 (Fed. Cir. 1984) It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Lalu*, 747 F.2d 703, 705; 223 USPQ 1257, 1258 (Fed. Cir. 1984) ... [Other references omitted] ... This it has not done. The Board points to nothing in the cited references, either alone or in combination, suggesting or teaching Fine's invention."

And further:

"Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art". *In re Keller*, 642 F.2d 413; 208 USPQ 871 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination". *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.* Here, the prior art contains none."

### Examiner's Rejection

The Examiner has summarily rejected claims 13 and 20 under 35 USC §103(a) as being unpatentable over Popcock (US 6,314,577) or as being unpatentable over Popcock (US 6,314,577) in view of Official Notice. The Examiner states that Popcock '577 provides all the steps of the claimed methods except that the communication device of Popcock '577 is not

portable. The Examiner points to Popcock '577, column 2, lines 37-45; and column 3, line 57, to column 4, line 11 as support for his rejection.

The applicant traverses the Examiner's position with relation to claims 20 and 13 for at least the following reasons.

column 2, lines 37-45

This section of Popcock requires a user to recall and preview music pieces that are replayed by an automated transaction system. The user compares their memory of the music they are interested in to a playback list from a particular radio station. This is completely different from the method of the invention as claimed by the applicant. The Examiner is directed to steps a, c, d, e, f, g, and h of claim 13 and steps a, c, d, e, f, and g of claim 20, both as amended. None of these steps are provided by the method disclosed in Popcock. The present invention is a music identification system that compares an actual segment of music, provided by the user and entered into the system by the user, to a database of prerecorded music. The claimed invention allows the user to identify an audible segment of music that user is in proximity to – whether from a radio, an elevator, a store's CD player, etc. Popcock requires a complex method of obtaining playlists for every radio station. A caller must know the station and time that the music was being played. The listener must remember the song while he listens to predetermined portions of songs from playlist for a particular station near the time the caller specified.

column 3, line 57, to column 4, line 11

This section of Popcock requires discloses a management system for a radio's program schedule by using a fax interface to receive the program schedule directly from the radio station into the programmed data processor. It is unclear to the applicant what this has to do with the present invention and clarification from the Examiner is requested.

Claim 13

Claim 13, as amended, now requires that the method steps are performed either by the user or by the music identification device and particularly. The novelty of Popcock was that it allowed a user to manually scroll through a playback list and identify a song previously heard on a particular radio station supported by the system. The comparison and analysis was done by the user and depended on the memory of the user. In particular, Popcock does not disclose steps a, c, d, e, f, g, and h, of claim 13, as amended. Claim 13, as amended, requires the user to record and transmit an actual segment of music to the music identification device. The comparison of the recorded segment of music to known musical works is done automatically by the music identification device. This is not shown or disclosed by Popcock.

Claim 13 is now believed to be distinguished over Popcock '577 and appropriate action by the Examiner is requested.

Claim 20

Claim 20, as amended, now requires that the method steps are performed either by the user or by the music identification device. In particular, Popcock does not disclose steps a, c, d, e, f, and g of claim 20, as amended. Claim 20, as amended, requires the user to transmit an actual segment of audible music using a portable communication device directly to the music identification/purchasing system. The comparison of the transmitted segment of music to known musical works is done automatically by the music identification device. This is not shown or disclosed by Popcock.

Claim 20 is now believed to be distinguished over Popcock '577 and appropriate action by the Examiner is requested.

It is also respectfully requested that if the Examiner rejects the claims as amended as obvious, that the Examiner meet the requirements of a *prima facie* case of obviousness. The claims have now been significantly amended over the original claims, accordingly, it is requested that the Examiner provide particular arguments directed at the claims as amended. In view of the claim amendments and of the arguments set forth above, prompt reconsideration and allowance of the claims is earnestly requested.

Respectfully submitted,

HAHN LOESER & PARKS, LLP

By 

Robert J. Clark

Reg. No. 45,835

Tel.: (330) 864-5550

Fax: (330) 864-7986